

2024728-7034082001
BSC No. 02-061**REMARKS**

Claims 1, 33 and 51 have been amended to clarify the claim language. No new matter has been added. Claims 1-9, 11-23 and 25-66 remain pending in this application and all stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Burbank (6312429) in view of Mahvi (2002/0022864). Without conceding that Mahvi is actually prior art, Applicants respectfully traverse and request reconsideration and withdrawal of the rejections.

As a preliminary matter, Applicants reserve the right to submit evidentiary affidavits or declarations under 37 C.F.R. §1.131 to antedate the Mahvi publication for purposes of removing it as prior art under §103/102(e)(1). In the meantime, Applicants respectfully submit that the question of whether Mahvi is properly prior art as to the present application is moot, since it does not provide a proper basis for sustaining the present claim rejections.

In order to establish a case of obviousness under 35 U.S.C. §103 by combining references, there must be some suggestion or motivation provided either in the references themselves or in the generally available knowledge to combine the reference teachings, as well as some reasonable expectation of success in so doing. (M.P.E.P. §706.02(j)). According to the office action:

One having ordinary skill in the art would be motivated to place the return electrode as taught by Burbank on the second electrode array of Burbank based on Mahvi[']s teachings in order to increase lesion size and create a more regular lesion area than would be possible with the monopolar device.

Applicants respectfully disagree. The Burbank device includes a trocar 22 removably attached to a handle 24, and having an electrosurgical cutting distal tip electrode 30 that is used in a monopolar fashion to cut through subcutaneous tissues in order to position the trocar in a target tissue mass. (See, e.g., col. 3, line 45 to col. 4, line 33). Once the trocar is positioned, respective pluralities of curved "locator wires" 42 and 50 are deployed (via thumb control 98) from an

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intermediate portion 33 of the trocar within the tissue mass in order to anchor the trocar and mark the site for -- i.e., identify the tissue to be removed during -- a subsequent surgical procedure. (See, e.g., col. 11, line 51 to col. 12 line 6). The tips of the locator wires may be electrically energized to facilitate their deployment "electrosurgically," but the wires 42 and 50 are *not* used to perform an ablation procedure. Instead, once the locator wires are in place, the handle 24 is removed from the trocar. (see col. 12, lines 8-14).

According to Burbank:

The patient can then be removed to the surgical operating room, with the trocar portion 22 remaining in place, for the surgeon to perform the appropriate surgery. The trocar portion 22 is unlikely to shift position in the tissue as the patient is removed because the locator wires 42, 50 assist in holding the trocar in position. This is true even when the tissue is removed from a compressed condition on a mammography apparatus. When the surgeon opens the tissue region, the trocar and the deployed locator wires 42, 50 provide the surgeon direct indication of the area of tissue to be removed or otherwise operated upon.

Col. 12, lines 15-25.

Thus, the "electrosurgical lesion location device" disclosed and described in Burbank is used to isolate and mark tissue that is to be subsequently removed surgically. It is not a device used to ablate the tissue. Rather, the electrosurgical aspects of Burbank are employed for the purpose of facilitating movement of the trocar tip 30, and locator wires 42 and 50, through tissue and into position, before the handle 24 is removed and the patient operated on. The sentence in Burbank at col. 4, lines 25-28, cited in the Office Action for the proposition that the Burbank device "can be bipolar," clearly refers to operation of the tip electrode 30 and *not* to an ablation procedure using the respective locator wires 42 and 50.

In sum, there would have been no motivation for one skilled in the art to modify the tissue localization device of Burbank in view of Mahvi in order to use the first and second locator wires in

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the Burbank device to perform a bi-polar ablation procedure. Neither of Burbank and Mahvi contains any suggestion, express or implied, that they be used in combination with a device such as with each other. Burbank is used as part of a conventional surgical resection procedure, whereas Mahvi is used to thermally ablate tissue in place. To so modify Burbank would be to completely change its function and design, and there is no teaching or suggestion in Burbank as to how the device could be used for volumetric tissue ablation.

For at least the foregoing reason, Applicants respectfully submit that a prima facie case for the § 103 rejection of the claims of the present application have not been established, and request that they be withdrawn.

CONCLUSION

Based on the foregoing, the present application is believed in condition for allowance. If the Examiner has any questions or comments regarding this response, please contact the undersigned at the number listed below.

Respectfully submitted,
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Dated: _____

6/7/05

By: _____

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